

REMARKS

I. Status of Claims

Claims 1-10, 12-18, 20-34, and 37-44 are pending in this application and claims 13, 15, 23-29, and 37-44 have been withdrawn as directed to a non-elected subject matter. No amendments are made by this Reply.

II. Claim Rejection under 35 U.S.C. § 103

In this Office Action, the Examiner maintains the rejection of claims 1-10, 12, 14, 16-18, 20-22, and 30-34 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 5,482,704 to Sweger et al. ("Sweger") and U.S. Patent No. 6,277,893 to Babenko ("Babenko"), in view of U.S. Patent No. 5,919,438 to Saint-Leger ("Saint-Leger") and U.S. Patent No. 5,720,964 to Murray ("Murray"). Office Action at page 2. In reply to Applicants' arguments presented in the Response filed on November 24, 2004, the Office contends that (1) Applicants impermissibly argued against the references individually, (2) Sweger (the primary reference) does not require the composition to have fatty acid soaps, and (3) the motivation to combine the references is based on Sweger's teaching of superior properties of amphoteric starch and the secondary references disclosure of other ingredients that are old and well-known cosmetic ingredients. *Id.* at pages 4 and 5. Applicants respectfully disagree for the reasons of record and for the additional reasons provided below.

Specifically, the Office baldly asserts that "one cannot show nonobviousness by attacking references individually, where the rejections are based on combinations of references." Office Action at page 4 (citing *In re Keller*, 642 F.2d 413 (C.C.P.A. 1981) and *In re Merck & Co.*, 800 F.2d 1091 (Fed. Cir. 1986)). But, the Office fails to explain

where or how our arguments are based on the references individually. Instead, Applicants asserted that each reference teaches separate elements of the claimed invention but no reference suggests or teaches the particular combination of the recited components from among all the possible ingredients for use in a cosmetic composition. In fact, we argued that as provided in the M.P.E.P. § 2145,

There *must* be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine teachings. The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references

Although the Office continues to assert there is a motivation to combine based on Sweger's teaching of superior properties of amphoteric starch and the secondary references disclosure of other ingredients that are old and well-known cosmetic ingredients (Office Action at page 5, lines 10-21), this does amount to the necessary teaching or suggestion to establish a *prima facie* case of obviousness. See M.P.E.P. § 2143.

The Office's rationalization of a motivation to combine based on properties of the ingredients themselves and that the ingredients can be used in cosmetic compositions is not enough. Under such a rationale, the Cosmetic Ingredient Dictionary and Handbook, which identifies various well-known cosmetic ingredients as well as properties associated with those ingredients, could be used to defeat patentability of almost all cosmetic inventions by its listing of ingredients. This is not logical and is the kind of inappropriate patentability determination addressed in *In re Rouffet*, 149 F.3d 1350, 47 U.S.P.Q.2d 1453 (Fed. Cir. 1998).

The Federal Circuit in *Rouffet* explained that “virtually all [inventions] are combinations of old elements.” 149 F.3d at 1357, 47 U.S.P.Q.2d at 1457. But more importantly, the court stressed that

an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat patentability of the claimed invention. Such an approach would be ‘an illogical and inappropriate process by which to determine patentability.’

Id., 47 U.S.P.Q.2d at 1457 (citation omitted). Instead, what is required is that “the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.” *Id.*, 47 U.S.P.Q.2d at 1458. Moreover, this evidence must be “clear and particular” showing a motivation to combine. *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). In the present case, the Office fails to make such a showing.

Furthermore, the Office’s basis for the determination of obviousness cannot be what the skilled person *might* try or find obvious to try. See *In re O’Farrell*, 853 F.2d 894, 7 U.S.P.Q.2d 1673 (Fed. Cir. 1988). Specifically, the Federal Circuit has identified some situations that exemplify an “obvious to try” rationale. *Id.* For example, an “obvious to try” rationale can be found where one “var[ies] all parameters or tr[ies] each of numerous possible choices until one possibly arrived at a successful result, [because]

the prior art gave either no indication of which parameters were critical or no direction as to which of many possible choices is likely to be successful.” *Id.* at 903, 7 U.S.P.Q.2d 1681 (citation omitted). Additionally, “what was ‘obvious to try’ was to explore a general approach that seemed to be a promising field of experimentation, where the prior art gave only guidance as to the particular form of the claimed invention.” *Id.* Thus, prior art identifying an ingredient with beneficial properties or even typically used in cosmetic compositions amounts to providing a general approach, which is not a suggestion or teaching in the art establishing a *prima facie* case of obviousness.

In addition, the Office asserts that Sweger (the primary reference) does not require the composition to have fatty acid soaps. Office Action at pages 4 and 5. Specifically, the Office alleges that “one of ordinary skill in the art would not review the particular examples as the full scope of teachings in Sweger et al.” *Id.* Despite the Office’s allegations, “a reference must be considered not only for what it expressly teaches, but also what it fairly suggests.” *See In re Burckel*, 592 F.2d 1175, 1179, 201 U.S.P.Q. 67, 70 (C.C.P.A. 1979). Sweger and Babenko admittedly lack a disclosure that “fairly suggests” using washing bases, cationic polymers, and surfactants in combination. *See* Office Action at page 3, ll. 10-12. Sweger and Babenko disclose a myriad of additional additives but without the particularity required to provide such a motivation as required. For this additional reason, there is no suggestion or motivation to combine these cited references and as such, a *prima facie* case of obviousness cannot be established.

III. Conclusion

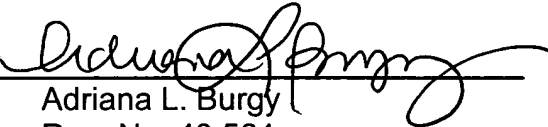
In view of the foregoing Remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

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